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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/606,879

06/27/2003

Lieven Stuyver

BJS-2551-123

5237

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EXAMINER

PENG, BO

ART UNIT

PAPER NUMBER

1648

MAIL DATE

DELIVERY MODE

12/18/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/606,879	Applicant(s) STUYVER ET AL.	
	Examiner BO PENG	Art Unit 1648	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 December 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 08 December 2009. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: 35,36 and 38.
 Claim(s) rejected: 16,28,29 and 35-40.
 Claim(s) withdrawn from consideration: 18-27,31,32 and 34.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/BO PENG/
 Primary Examiner, Art Unit 1648

Continuation of 3. NOTE: New limitations added to the claims 36 step (iv) raise new issue and require new search and further consideration.

Continuation of 11. does NOT place the application in condition for allowance because: Applicants' arguments are not sufficient to overcome all outstanding rejections:

In response to the rejection of Claims 16, 28, 29 and 35-40 under 35 U.S.C. 112, 1st, Applicants argue that the claims are supported by an adequate written description and that one of ordinary skill will be able to make and use the claimed invention without undue experimentation. This argument is not sufficient to overcome the rejection. As indicated in the Final Office action, para 13, the scope of new Claim 36 encompasses use of any undefined nucleotide probes of about 5 to 50 nucleotides long to specifically detect "the presence or absence of HBV genotype A", but not other HBV genotypes, in a sample. However, the newly cited primers SEQ ID NOs: 75, 76, 94, 105, 112, 134 and 135 appear to overlap with HBV genomes of other genotypes see Specification, Fig. 1., indicating that the cited primers are not genotype-specific. Since the cited primers in Claim 36 cannot yield the required result of "determining the presence or absence of HBV genotype A in a biological sample" cited in the preamble of Claim 36, one of ordinary skill in the art will NOT be able to make and use the claimed invention, without undue experimentation.

In response to the 103 rejection of Claims 36 and 39, Applicants argue that the four primers as indicated amplify the HBsAg region of many different genotypes in a very efficient way, and the use of these primers is an unexpected advantage of the claimed invention. This argument is considered, but not persuasive. This argument is not relevant to the claims. It is noted that "the four primers" are not required in the claimed method. See Para 19, the final office action, dated June 8, 2009.

If the amendment were entered, the objection to Claim 38 under 37 CFR 1.75, as being a substantial duplicate of claim 29, would be moot in view of the amendment to the claim. The objection to Claims 35 and 36 as indefinite would be withdrawn in view of the amendment to the claims.

If the amendment were entered, the rejection of Claims 16 and 35 under 35 U.S.C. 112, 1st would be withdrawn.